

REMARKS

I. General

Claims 1-39 are pending in the present application. Claims 1, 9, and 24 are amended and claims 3, 12, 13, and 35 are canceled herein. Claims 1-2, 4, 6-12, 15, 18-25, 27-30, 33-34, and 36-39 stand rejected under 35 U.S.C. § 102(b). Claims 3, 5, 13, 15-17, 26, 31, 32, and 35 stand rejected under 35 U.S.C. § 103(a). Applicant respectfully traverses the rejections of record and requests reconsideration in light of the arguments below.

II. Claim Amendments

Claim 1 has been amended to incorporate the limitations of dependent claim 3. Accordingly, claim 1 presents originally submitted claim 3 in independent form. Claim 9 has been amended to incorporate the limitations of dependent claims 12 and 13 thereby placing claim 13 in independent form. Claims 14-19 have been amended to depend from claim 9 rather than canceled claims 12 and 13. Claim 24 has been amended to incorporate the limitations of claim 35 thereby placing claim 35 in independent form. No new matter has been added. Moreover, as the limitations of amended claims 1, 9, and 24 have been previously presented and considered by the Examiner, no further search and consideration is required and the amendments should be entered after final.

III. Improper Final Office Action

The Examiner has the burden of establishing a *prima facie* case of anticipation, *In re Skinner*, 2 USPQ2d 1788, 1788-89 (B.P.A.I. 1986). Likewise, the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness, M.P.E.P. § 2142; *In re Peehs*, 204 U.S.P.Q. 835, 837 (CCPA 1980).

In response to the Office Action mailed February 21, 2007, Applicant showed how the rejections of record failed to establish *prima facie* anticipation under 35 U.S.C. § 102 or *prima facie* obviousness under 35 U.S.C. § 103. In response, the Examiner now, in the Office Action mailed August 31, 2007, points to different portions of the applied references in an attempt to redress the deficiencies in the rejections identified by Applicant. However, despite presenting these new grounds of rejection, the Examiner has made the Office Action mailed August 31, 2007 final.

As set forth in M.P.E.P. § 706, “[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.” Further, the Examiner is admonished that “[t]he examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing,” M.P.E.P. § 706.07. Accordingly, “[w]hen a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable,” 37 C.F.R. § 1.104(c)(2).

However, in contradiction to the requirements set forth in the Rules and the Manual of Patent Examining Procedure, the Examiner failed to clearly designate the particular parts of the applied references relied upon and now, in a final Office Action, identifies different portions of the applied references in rejecting the claims. In an apparent attempt to justify the finality of the Office Action in light of such new rejections, the Examiner points out that the previous Office Action stated that “although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well,” final Office Action at page 2. The foregoing is tantamount to the Examiner rejecting the claims based upon an assertion that the claimed subject matter is in the prior art and the Examiner invites Applicant to both locate such subject matter and postulate as to an appropriate rejection. Such a statement is simply insufficient to establish *prima facie* anticipation or obviousness of the claim and cannot be relied upon to relieve the Examiner of the burden to initially establish a *prima facie* case before Applicant is required to provide evidence as to patentability.

Furthermore, section 706.07 of the M.P.E.P. directs that “[i]n making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated. They must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal unless a single previous Office Action contains a complete statement supporting the rejection.” The final Office Action and previous Office Action in this case have failed to clearly develop all grounds of rejection; thus, the finality of the office action is improper.

For example, claim 2 recites “the information about each of the mail pieces includes information in the group consisting of: recipient address information; postal class of the mail piece; weight of the mail piece; and contents of the mail piece.” Both the Office Actions fail to clearly develop the ground for rejection as the office actions merely cite paragraph [0031] without explaining which elements in paragraph [0031] teach the limitations of claim 2. However, paragraph [0031] fails to discuss information comprising of recipient address information, postal class of the mail piece, weight of the mail piece, and contents of the mail piece, and the Examiner has failed to point to the portion of the reference which teach these limitations. Thus, neither Office Action clearly developed the grounds for rejection such that Applicant may readily judge the advisability of an appeal. Applicant respectfully requests clarification in a non-final Office Action.

In another example, claim 15 recites “wherein a single image is printed on a plurality of labels; and wherein the plurality of labels are printed with indicia representing at least two different postage amounts.” In rejecting this limitation, both the Office Actions merely cite FIGURE 6 without detailing what in FIGURE 6 teaches the various elements of this limitation. Applicant notes that this limitation requires “a plurality of labels” and “at least two different postage amounts.” FIGURE 6 only discloses a single stamp with a single postage amount, and the Office Actions have not explained how a single stamp can teach a plurality of stamps or how a single postage amount can disclose at least two different postage amounts. Accordingly, the Office Actions have failed to clearly develop the grounds for rejection such that Applicant may readily judge the advisability of an appeal. Applicant respectfully requests clarification in a non-final Office Action.

As shown above, asking Applicant to pick through the art and guess at what the Examiner believes teaches elements of the claims does not afford the Applicant a full and fair opportunity to evaluate the patentability of his invention. The M.P.E.P. explains that “[t]o bring the prosecution to as speedy conclusion as possible and at the same time to deal *justly by both the applicant and the public*, the invention as disclosed and claimed should be thoroughly searched in the first action and the *references fully applied*; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection” (emphasis added). M.P.E.P. 706.07. By failing to clearly point to elements in the reference which the Examiner relies on as teaching the limitations of the claim, Applicant is

at a loss in determining how to amend the claims to avoid all the grounds of rejection. Accordingly, Applicants respectfully request, pursuant to M.P.E.P. § 706.07(c), that the Examiner reconsider the final status of the Office Action and withdraw the finality of the rejection pursuant to M.P.E.P. § 706.07(d).

IV. The Claim Rejections

Claims 1-2, 4, 6-12, 15, 18-25, 27-30, 33-34, and 36-39 are rejected under 35 U.S.C. § 102(b) as being anticipated by United States Publication No. 2002/0073039 to Ogg et al. (hereinafter *Ogg*). Claims 3, 26, and 35 stand rejected under 35 U.S.C. § 103(a) as unpatentable over *Ogg*. Claims 5, 13, 15, 16, 17, 31 and 32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ogg* in view of United States Publication No. 2003/0140017 to Patton et al. (hereinafter *Patton*).

It is well settled that to anticipate a claim, a reference must teach every element of the claim, *see* M.P.E.P. § 2131. Similarly, an obviousness rejection is improper when the differences between the applied art and the claims set the claims apart from the applied art, *see United States v. Adams* 383 U.S. 39, 48 (1966). Applicant respectfully asserts that the rejections do not satisfy these requirements, and thus traverses the rejections of record.

A. The Independent Claims

As previously pointed out by Applicant, claim 1 recites “a controller for monitoring the mail pieces as they are processed by the system” In response to Applicant’s previously submitted arguments, the Examiner asserts that “Ogg (039) is clear that before a postage label is printed for a mail piece, the associated information regarding that mail piece is entered into a controller (computer based postage system) and monitored by said controller to determine the proper postage value,” final Office Action at page 3. However, the foregoing is irrelevant to the claim limitation. The Examiner has failed to establish that *Ogg* teaches a controller for monitoring the mail pieces as they are processed. As such, the 35 U.S.C. § 102 rejection of record is improper.

In an effort to expedite prosecution, Applicant has amended claim 1 to recite the limitations of claim 3. Accordingly, claim 1, as amended, recites that “the postage evidencing system prints two or more labels for a particular mail piece, the combined postage

value of the two or more labels equaling at least the required postage for the mail piece.” The Examiner states that *Ogg* does not disclose printing two or more labels for a particular mail piece, but asserts that it is well known in the art that a sender can use multiple stamps on a mail piece as long as the value of the multiple stamps add up to be at least the required postage, final Office Action at page 13. However, in order to establish *prima facie* obviousness under 35 U.S.C. § 103, the Examiner must provide analysis supporting any rationale why a person skilled in the art would combine the prior art to arrive at the claimed invention, and “[such] analysis should be made explicit,” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. ____ (2007). Even if it is well known that multiple stamps may be used on a mail piece, there is nothing to support an assertion that one of ordinary skill in the art would have modified *Ogg*, which teaches the calculation and printing of postage indicia, to print postage indicia of incorrect amounts to therefore print two or more labels for any particular mail piece, nor has the Examiner shown otherwise. The 35 U.S.C. § 103 rejection of record is thus improper.

Claim 9, as amended, recites “printing an image on the blank labels in addition to the postage indicia . . . wherein the image is selected based upon one or more characteristics of the particular recipient.” The Examiner states that *Ogg* does not disclose that the image is selected based upon a characteristic of the recipient, but asserts that *Patton* discloses “a method of generating stamps with user selected images, and the images can be based on a characteristic of the recipient,” final Office Action at pages 15 and 16. That the images of *Patton* can be based on a characteristic of the recipient is insufficient to teach that images are selected based upon one or more characteristics of the particular recipient as expressly set forth in the claim.

Consistent with the foregoing, *Patton* does not provide any disclosure to teach selection of an image based upon a characteristic of the recipient. *Patton* merely teaches that “[w]hen the consumer selects ‘From Collection’ button 70 on decision screen 61 (FIG. 8), the process goes to step 74 and the . . . image category screen 75 displays a plurality of thumbnail-size images 76, which represent different categories of images, such as animals, flowers, landscapes, etc.,” paragraph [0038]. “When the consumer selects an image 76 representing a category on the image category screen 75, the consumer goes to step 78, which displays gallery screen 80 (FIG.13) comprising a plurality of different thumbnail size images

76 [and t]he consumer chooses an image by selecting the thumbnail of the desired image 76 which results in the selected image appearing in the window of the image manipulation screen 74 (FIG. 14),” *id.* There is nothing in this disclosure to teach selection of an image based upon one or more characteristics of the particular recipient, nor has the Examiner shown otherwise.

Claim 24, as amended, recites “monitoring the progress of mail pieces in a high-speed letter processing system” The rejection of record asserts that *Ogg* teaches monitoring the progress of mail pieces in a letter processing system and paragraph [0031], final Office Action at page 14. However, at paragraph [0031] *Ogg* discusses a user interface into which a user enters postage information. There is nothing to teach monitoring the progress of mail pieces in a letter processing system, whether high-speed or otherwise.

The Examiner states that *Ogg* does not teach a high-speed letter processing system, but asserts that high-speed processing systems are well known in the art as evidenced by Katikaneni et al., United States patent application publication number 2002/0073052. However, the Examiner must provide analysis supporting any rationale why a person skilled in the art would combine the prior art to arrive at the claimed invention, and “[such] analysis should be made explicit,” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. ____ (2007). Merely opining that high-speed processing systems are well known in the art is insufficient to establish obviousness under 35 U.S.C. § 103, see “Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*,” 72 Fed.Reg. 57526.

Moreover, claim 24, as amended, recites “coordinating the operation of the postage stamp applicator and a postage evidencing system that creates the stamps to ensure that the correct postage stamps are applied to each envelope.” The rejection of record asserts that *Ogg* teaches the foregoing at paragraph [0034], final Office Action at page 14. However, at paragraph [0034] *Ogg* discusses operation with respect to whether a print wizard was used to generate the request to print computer-based postage stamps. There is nothing to teach coordinating the operation of a postage stamp applicator and a postage evidencing system that creates the stamps to ensure that the correct postage stamps are applied to each envelope. As such, the rejection of record is improper.

B. The Dependent Claims

Claims 2, 4-8, 10, 11, 14-23, 25-34, and 35-39 each depend directly or indirectly from a respective one of claims 1, 9, and 24, thereby inheriting each limitation of the respective base claim. Therefore, the dependent claims are asserted to be patentable over the rejections of record at least for the reasons set forth above with respect to their respective one of claims 1, 9, and 24.

V. Conclusion

In view of the above, Applicant believes the pending application is in condition for allowance. Accordingly, Applicant requests that the claims be passed to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 61135/P022US/10303187 from which the undersigned is authorized to draw.

Dated: October 31, 2007

Respectfully submitted,

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4).

Dated: October 31, 2007

Signature: 
(Lisa deCordova)

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